

IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF TEXAS  
MARSHALL DIVISION

WILUS INSTITUTE OF STANDARDS AND  
TECHNOLOGY INC.,

Plaintiff,

v.

HP INC.

Defendant.

Civil Case No. 2:24-cv-00752-JRG  
[Lead Case]

JURY TRIAL DEMANDED

WILUS INSTITUTE OF STANDARDS AND  
TECHNOLOGY INC.,

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD.,  
SAMSUNG ELECTRONICS AMERICA,  
INC.

Defendants.

Civil Case No. 2:24-cv-00746-JRG  
[Member Case]

JURY TRIAL DEMANDED

WILUS INSTITUTE OF STANDARDS AND  
TECHNOLOGY INC.,

Plaintiff,

v.

HP INC.

Defendant.

Civil Case No. 2:24-cv-00764-JRG  
[Member Case]

JURY TRIAL DEMANDED

<p>WILUS INSTITUTE OF STANDARDS AND TECHNOLOGY INC.,</p> <p>Plaintiff,</p> <p>v.</p> <p>SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS AMERICA, INC.</p> <p>Defendants.</p>	<p>Civil Case No. 2:24-cv-00765-JRG [Member Case]</p> <p>JURY TRIAL DEMANDED</p>
<p>WILUS INSTITUTE OF STANDARDS AND TECHNOLOGY INC.,</p> <p>Plaintiff,</p> <p>v.</p> <p>ASKEY COMPUTER CORP., ASKEY INTERNATIONAL CORP.</p> <p>Defendants.</p>	<p>Civil Case No. 2:24-cv-00766-JRG [Member Case]</p> <p>JURY TRIAL DEMANDED</p>
<p>WILUS INSTITUTE OF STANDARDS AND TECHNOLOGY INC.,</p> <p>Plaintiff,</p> <p>v.</p> <p>ASKEY COMPUTER CORP., ASKEY INTERNATIONAL CORP.</p> <p>Defendants.</p>	<p>Civil Case No. 2:24-cv-00753-JRG-RSP [Member Case]</p> <p>JURY TRIAL DEMANDED</p>

**SAMSUNG DEFENDANTS’ RESPONSE TO WILUS’S NOTICE OF SUPPLEMENTAL  
AUTHORITY IN SUPPORT OF MOTION TO DISMISS SAMSUNG’S AMENDED  
COUNTERCLAIMS 1-2 (DKT. 137)**

Samsung disagrees that recent rulings in *Roku, Inc. v. Access Advance LLC et al.*, No. 1:24-cv-13217-RGS (“*Roku*”), Dkt. Nos. 51–53 (D. Mass.), raised in Wilus’s Notice of Supplemental Authority (Dkt. 137) support dismissal of Samsung’s counterclaims. At bottom, the dismissal of

a rate-setting action in the *Roku* case has no bearing on Samsung’s fundamentally distinct claims for breach of FRAND contract and breach of duty of good faith.

In *Roku*, Roku, Inc. (“Roku”) brought a case against a patent pool (Access Advance LLC) and two members of that patent pool (Dolby and SPT) (collectively, “Defendants”) seeking, among many other claims, a declaratory judgment of “FRAND terms and conditions” (“Count IX”). *Roku*, Dkt. No. 27 at ¶¶ 175–77 (D. Mass.). Prior to the filing of the *Roku* case, Defendants had filed suit against Roku in the Unified Patent Court (“UPC”) in Germany based on related issues and patents. Defendants filed a motion to dismiss Roku’s case primarily on personal jurisdiction grounds, and further argued that the Court should use its discretion to refrain from hearing a declaratory judgment case (1) to avoid duplicative proceedings with the UPC and (2) because Roku allegedly filed the case as a tactical measure to strengthen its negotiation position. *See Roku*, Dkt. No. 33 at 7–11. In response, Roku argued there is an actual, immediate, and direct controversy between Roku and Defendants as to the proper “FRAND rate.” *Roku*, Dkt. No. 41 at 12–13. The Court granted the Defendants’ motion to dismiss because Roku failed to establish personal jurisdiction over Dolby and SPT. *See Roku*, Dkt. No. 51. The Court issued a further order dismissing the remaining claims against Access Advance. *See Roku*, Dkt. No. 52. With respect to Count IX—declaratory judgment of “FRAND terms and conditions”—the Court stated it “lacks jurisdiction to determine the FRAND rate” because “[t]he U.S. patents constitute only a fraction of the larger portfolio which includes hundreds of foreign patents. and the court’s opinion on the appropriate royalty rate would merely be advisory.” *Id.*

Here, Samsung does not ask the Court to set “FRAND terms and conditions” for any patent. Instead, Samsung asks the Court to adjudicate (1) whether Wilus breached its contract with the IEEE and (2) whether Wilus breached its duty of good faith. *See Dkt. 48 at 52–58 (¶¶ 46–73).*

The rate-setting claims in *Roku* are fundamentally different from Samsung’s breach of contract claims here, and there is no question this Court has jurisdiction to hear a breach of FRAND contract claim—including one that implicates non-U.S. patents. *See Roku*, Dkt. No. 27, ¶¶ 150–57, 158–61, 175–77 (pleading “Breach of Contract – FRAND,” “Breach of the Implied Covenant of Good Faith and Fair Dealing,” and “Declaratory Judgment of FRAND Obligations” as separate counts); *see also, e.g., G+ Commc’ns, LLC v. Samsung Elecs. Co.*, No. 2:22-cv-00078-JRG, 2022 WL 4593080, at \*2–3 (E.D. Tex. Sept. 29, 2022) (denying motion to dismiss breach of FRAND contract counterclaim).

The present case is distinguishable from *Roku* in a number of other ways. **First**, Roku was a declaratory judgment action, whereas Samsung asserts a breach of contract claim here. *Compare* Dkt. 48 at 52–58 (¶¶ 46–73) *with Roku*, Dkt. No. 27, ¶¶ 175–77. Thus, jurisdiction is not discretionary here, as it was in *Roku*. *See Roku*, Dkt. No. 33 at 7–10 (requesting the Court to “exercise its broad discretion under the Declaratory Judgment Act to decline to hear Counts I–IV and IX . . .”). **Second**, Samsung has not filed any overlapping co-pending litigation, as was the case in *Roku*. *See Roku*, Dkt. No. 33 at 7–10. Therefore, there is no risk of duplicative proceedings and/or inconsistent rulings here. *Contra id.* **Third**, Wilus—not Samsung—brought this patent infringement lawsuit involving patents that are subject of the parties’ licensing negotiations regarding the Wilus portfolio. *See Wilus Inst. of Standards & Tech. Inc. v. Samsung Elecs. Co. et al.*, No. 2:24-cv-00746, Dkt. No. 1 (E.D. Tex.); *Wilus Inst. of Standards & Tech. Inc. v. Samsung Elecs. Co. et al.*, No. 2:24-cv-00765, Dkt. No. 1 (E.D. Tex.). There is thus little, if any, risk of additional interference with the parties’ license negotiations as a result of this Court adjudicating Samsung’s breach of FRAND contract and breach of duty of good faith counterclaims. *Contra Roku*, Dkt. No. 33 at 7–10.

For these reasons, the *Roku* case is not instructive, and Samsung maintains that it has sufficiently pled its counterclaims.

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Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing document was filed electronically in compliance with Local Rule CV-5 on August 7, 2025. As of this date, all counsel of record have consented to electronic service and are being served with a copy of this document through the Court's CM/ECF system under Local Rule CV-5(a)(3)(A).

/s/ Ralph A. Phillips